

REMARKS

In response to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Applicant amends claims 1, 5 and 8. No claims have been added, no claims have been cancelled. Accordingly, claims 1-19 are pending.

The instant invention is directed to a golf bag comprising a body portion for receiving golf clubs, an upper case for supporting an upper end of the body portion, and a bottom case for supporting a lower end of the body portion and defining a bottom of the body portion, wherein the bottom case is formed through a foam forming process and is provided with a bottom plate having a different color from the bottom case.

I. Amendments to the Claims

In the attached Amendments to the Claims, Claims 1, 5 and 8 have been amended. Claim 1 has been amended to include the limitation of a "bottom plate having a different color from the bottom case" originally recited in dependent Claim 5. Claim 5 has been amended for consistency with Claim 1. Claim 8 has been amended to provide proper antecedent basis for "graphics" pursuant to the Examiner's request. Thus, the attached amendments are supported by the specification and do not add new matter. In view of the foregoing, Applicant respectfully requests consideration and entry of the attached Amendments to the Claims.

II. Election/Restrictions

In the outstanding Action, the Examiner withdraws Claims 9-16 and 18-19 pursuant to Applicant's reply filed on 11/26/2004. The Examiner further requires Applicant to elect a single species of the claimed invention represented by Groups I-IV. Applicant respectfully elects Group I: figs. 10A-10B pursuant to the Examiner's request. The claims readable on the elected species are Claims 1-8.

III. Drawing Objections

In the outstanding Office Action, the Examiner objects to the drawings under 37 CFR 1.83(a). Specifically, the Examiner states the drawings must show the projection being exposed to an external portion along with a hook and groove. Applicant respectfully submits the attached proposed drawings illustrating the hook 85 and groove 83 configuration. Applicant believes the proposed changes to the drawings overcome the Examiner's rejection under 37 CFR 1.83(a). Applicant respectfully requests the Examiner's acceptance of the proposed drawings and withdrawal of the objection to the drawings.

IV. Claims Rejected Under 35 U.S.C. § 112, second paragraph

Claims 6 and 8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to Claim 6, the Examiner alleges the claimed projection is not shown exposed to an external portion. Claim 6 depends from Claim 5. Applicant respectfully submits that Claim 6 does provide that the

referenced "hook projection" must be exposed to an external portion. Applicant believes the Examiner confuses the "projection" of the bottom plate "having an identical shape to the hole formed in the bottom" recited in Claim 5, with the limitation recited in dependent Claim 6. The claims only require the projection having an identical shape to the hole formed in the bottom be exposed to an external portion, not the "hook projection." In regard to Claim 8, Claim 8 has been amended to provide proper antecedent basis for the element of "graphics" by deleting the recitation of "the" before "graphics." Accordingly, reconsideration and withdrawal of the indefiniteness rejection is requested.

V. Claims Rejected Under 35 U.S.C. §§ 102(b)

Claims 1-4 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,941,398 issued to Nelson ("Nelson"). Applicant respectfully traverses the rejection for at least the following reasons.

Anticipation may only be established if "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In regard to amended Claim 1, Applicant respectfully submits Nelson fails to teach or suggest a golf bag having a bottom case formed through a foam forming process wherein the bottom case is provided with a bottom plate having a different color from the bottom case. Nelson teaches a golf club holder having a rigid elongated

body. See Nelson, Abstract. Nelson teaches that the “elongated body 16 made of a foamed plastic composition such as foamed polyurethane.” See Nelson, col. 2, lines 11-15. The elongated body 16 of Nelson, however, is not the same element as Applicant’s claimed bottom case 7. Accordingly, the Examiner has not pointed to any portion of Nelson teaching this element. The Examiner has further failed to indicate, and Applicant is unable to discern, any portion of Nelson teaching a bottom case with a bottom plate having a different color from the bottom case. Since Nelson fails to teach or suggest all the elements of Claim 1, anticipation may not be found. For at least the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of Claim 1 under 35 U.S.C. §102(b).

In regard to Claims 2-4, Claims 2-4 depend from Claim 1 and incorporate the limitations thereof. Thus, for at least the reasons discussed above in regard to Claim 1, Nelson fails to teach or suggest a bottom case provided with a bottom plate as found in Claims 2-4. Since each element of Claims 2-4 is neither taught nor suggested by Nelson, anticipation may not be found. For at least the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of Claims 2-4 under 35 U.S.C. §102.

In regard to Claim 17, Applicant respectfully submits Nelson fails to teach or suggest an upper case formed through a foam forming process. The Examiner alleges Nelson teaches a bag formed by foamed polyurethane and therefore this limitation is met. Applicant respectfully disagrees. As previously discussed, Nelson teaches that the elongated body 16 may be made of a composition such as foamed polyurethane (col. 2,

lines 11-15), however, an elongated body is not the same element as Applicant's claimed upper case 2. Accordingly, the Examiner has not pointed to any portion of Nelson teaching this element. Thus, Nelson fails to teach or suggest all the elements of Claim 17. Since Nelson fails to teach each and every element of Claim 17, anticipation may not be found. For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 17 under 35 U.S.C. §102(b).

V I. Claims Rejected Under 35 U.S.C. § 103(a)

Claims 5-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nelson in view of U.S. Patent No. 1,825,692 issued to Hayden ("Hayden"). Applicant respectfully traverses the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must show the cited references, combined, teach or suggest each of the elements of a claim. Claims 5-8 depend from Claim 1 and incorporate the limitations thereof. As set forth above in regard to Claim 1, Nelson fails to teach or suggest at least the elements of a bottom case formed through a foam forming process with a bottom plate having a different color from the bottom case. The Examiner has not pointed to and Applicant is unable to discern any portion of Hayden teaching these elements. Thus, neither Nelson nor Hayden, alone or in combination teach all the elements of Claims 5-8.

Moreover, the combination of Nelson and Hayden is entirely inappropriate. Nelson teaches a golf bag assembly. Hayden is directed to a rubber heel for application to a shoe. See Hayden, col. 1, lines 1-5. One of ordinary skill in the art would certainly

not be motivated to combine teachings directed to a golf bag with those directed to the rubber heel of shoe. Thus, it appears it is only upon viewing Applicant's disclosure that the Examiner has found motivation to combine the references. Such hindsight reconstruction is an inappropriate basis for combining references.

For at least the foregoing reasons, the Examiner has failed to show all the elements of Claims 5-8 are taught or suggested by Nelson in view of Hayden. Since each element of Claims 5-8 is not taught by the prior art, a *prima facie* case of obviousness may not be established. Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 5-8 under 35 U.S.C. §103.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nelson in view of U.S. Patent No. 6,648,137 issued to Hamamori ("Hamamori") or U.S. Patent No. 1,767,548 issued to Noe ("Noe"). Applicant respectfully traverses the rejection for at least the following reasons.

Claim 5 depends from Claim 1 and incorporates the limitations thereof. As set forth above in regard to Claim 1, Nelson fails to teach or suggest at least the elements of a bottom case formed through a foam forming process with a bottom plate having a different color from the bottom case.

Hamamori fails to cure the deficiencies of Nelson. The Examiner alleges it would have been obvious based upon Nelson in view of Hamamori to provide bottom holes and projections fitted in the bottom holes to provide cushion for the bag. See Action, page 3, paragraph 5. Applicant respectfully disagrees with the Examiner. Hamamori

teaches a bottom structure of a golf bag having legs. See Hamamori, col. 4, lines 53-67. The inventive purpose of the projections recited in Claim 5 is not to provide cushion for the bag. Instead, these projections of the bottom plate are inserted through holes in the bottom plate to provide identifying features on the bottom of the golf bag. Thus, modifying the references as suggested by the Examiner to arrive at a bottom cushion for a golf bag would not teach, suggest or motivate one of skill in the art, to provide a bottom case with a hole representing letters or graphics and further comprising a bottom plate having protrusions of identical shape to the hole such that the protrusion is fitted through the hole and exposed to an external portion. Accordingly, Hamamori does not cure the deficiencies of Nelson with respect to these elements.

Similarly, Noe does not cure the deficiencies of Nelson. Noe teaches a golf bag bottom with a piece 10 attached to the bottom of the bag by a central rivet 11 for supporting the bag off of the ground. See Noe, col. 2, lines 13-15; line 30. The metallic piece includes openings and serves to protect the bottom of the bag and while allowing for inspection of the bottom of the bag. See Noe, col. 2, lines 21-24. The Examiner alleges the bottom plate 10 and rivet 11 would have motivated one of ordinary skill in the art to provide a bottom plate in Nelson to provide a more rigid bottom. It is unclear to Applicant how modifying the references to teach a golf bag having a more rigid bottom teaches or suggests the elements of a golf bag having a bottom case provided with a hole representing letters or graphics, a bottom plate different in color from the bottom case having protrusions or identical shape to the hole formed in the bottom such that the protrusions may be fitted in the hole to be exposed at an external portion. The

Examiner alleges the bottom plate has a different color from the bottom of the case however nowhere does Noe teach that this is so. Accordingly, the Examiner has not pointed to, and Applicant is unable to discern, any portion of Noe teaching at least these elements of Claim 5.

Moreover, the references have been improperly combined. Hamamori teaches a golf bag having legs to support the bag when the bag is placed on the ground. See Hamamori, col. 5, lines 11-15; Fig. 5. Noe teaches the use of a plate to support a golf bag above the ground. See Noe, col. 2, lines 30-34. Nelson teaches a golf bag having wheels that allow the bag to be supported above the ground. See Nelson, Abstract; Fig. 1. Thus, the bottom of the bag described in Nelson does not contact the ground and therefore does not need the sort of protective elements taught by Hamamori and Noe. Accordingly, there would be no need to incorporate the retaining legs 44 taught by Hamamori or the plate 10 of Noe into the golf bag described in Nelson. Thus, upon viewing the references, one of ordinary skill in the art would not be motivated to arrive at the modification relied upon by the Examiner. It is only upon inappropriate hindsight reconstruction that the Examiner seems to find motivation for the combination. Hindsight is not an appropriate basis for combining references. Thus, at least for the foregoing reasons, Nelson in view of Hamamori or Noe fail to teach or suggest all the elements of Claim 5.

Since each and every element of Claim 5 is neither taught nor suggested by Nelson in view of Hamamori or Noe, a *prima facie* case of obviousness may not be

established. In view of the foregoing, Applicant respectfully requests withdrawal of the rejection of Claim 5 under 35 U.S.C. §103(a).

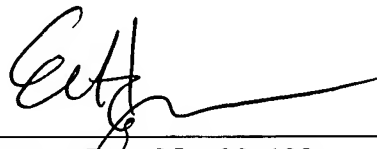
CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-19 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 5/23, 2005


Eric S. Hyman, Reg. No. 30, 139

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 23, 2005.


Jean Svoboda

May 23, 2005



ANNOTATED SHEET SHOWING CHANGES

FIG.10A

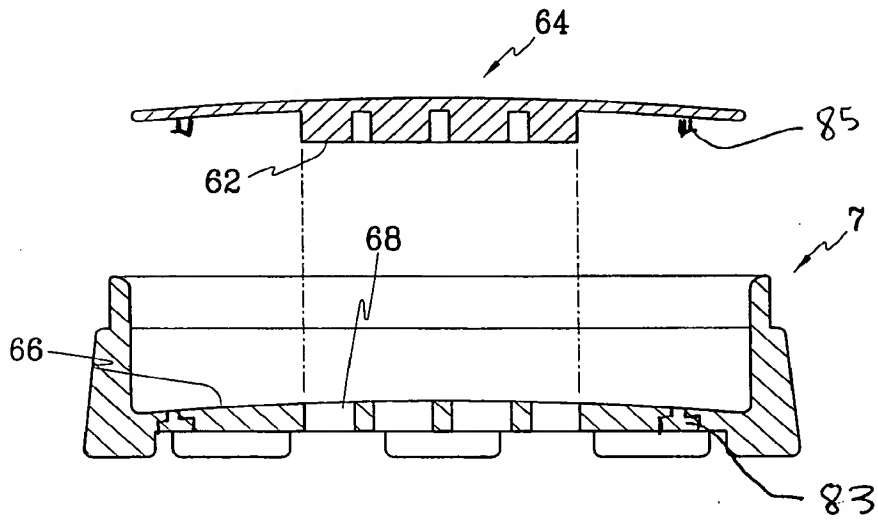


FIG.10B

